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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,732	06/28/2001	Noboru Iwayama	1405.1045	3572
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LE, KHANH H	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/892,732	<b>Applicant(s)</b> IWAYAMA ET AL.	
	<b>Examiner</b> Khanh H. Le	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2007 has been entered.

Claims 1-12, 14-15 remain pending. Claims 1-12, 14-15 are amended. Claims 1, 2, 9, 10, 11, 12, 14-15 are independent.

### *Specification*

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required (phrases such as "administrating status of users" or similar phrases are simply not meaningful English). The substitute specification filed must be accompanied by a statement that it contains no new matter.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Previous rejections to claims 1 and 14 under 35 U.S.C. 112, second paragraph, are withdrawn. However new ones under this section apply.

5. **Claims 1-9, 11-12, 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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**Independent claims 1, 2, 9, 11, 12, 14-15:**

Phrases such as "administrating status of users" or similar phrases are simply not meaningful English. Dependent claims are rejected based on the dependency. Appropriate correction is required.

Claim 11: "on receiving requests in advance" in the phrase " from a plurality of advertising data correlatively stored...on receiving requests in advance from an advertiser terminal device" is also not meaningful English. Appropriate correction is required.

Typographical errors such as "the a browsing status " (Claim 12); "the at lease" (Claim 15) need corrections.

**Response to Arguments**

6. Applicant's arguments have been fully considered but they are not effective in overcoming the prior art.

Applicants have not specifically and distinctly pointing out the supposed errors" in the last rejection as required by MPEP 714.02 and 37 CFR 1.111 (b).

The new limitations are addressed in the prior art discussion below.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claims 1-4, 9, 10, 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recommend-it.com, a set of 3 documents, which date back to 1998, as described further below, in view of Porat et al, US 20020026353 A1.**

8a. **"Want to See What We Can Do For Your Website? Click The Button To Test Us Out! " at Recommend-it.com , <http://web.archive.org/web/19980610011830/www.recommend-it.com/>, (4 pages, dated back to 1998), herein "Recommend-it document #1", discloses a system where a website (such as [www.webdeck.com](http://www.webdeck.com)) browsed by a 1<sup>st</sup> user (e.g." Eileen Velet" ) is detected and an email, disclosing the status of the 1<sup>st</sup> user ("velvet wants to you to check this site out" ) is sent to buddies of the 1<sup>st</sup> user indicating the website just visited by this user (see page 2 , left frame lines 5-7) ,and links to that website so the buddy can visit (see page 4, line 8) . Included in the email is description of the site and other "juicy details" of the site so that the "friend or colleague**

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will see exactly what the site contains before they visit" (see page 4 of 4). The description of the site and the "juicy details" of the site constitute an advertisement for the site to entice the buddy to visit.

**Recommend-it #1 further adds more ads in the invitation message ( see at page 4, the financial ad "Green Mountain Asset" tagged to the email message).**

**Recommend it, [http:// web.archive.org/web/19980610011837/www.recommend-it.com/user\\_reg.user\\_regHTML.fcgi](http://web.archive.org/web/19980610011837/www.recommend-it.com/user_reg.user_regHTML.fcgi), herein" Recommend-it document #2", (2 pages) shows setting up buddy lists to send recommended site identifiers to.**

**"Advertising rates" at Recommend-it.com, [http:// web.archive.org/web/19980610011859/www.recommend-it.com/html/advert.html](http://web.archive.org/web/19980610011859/www.recommend-it.com/html/advert.html), herein" Recommend-it document #3", (2pages) discloses solicitation of advertisers and advertising pay rates.**

**8b. Thus as to independent claims 1, 10, 12, 14-15, Recommend-it discloses:**

An advertising method, system, computer program for broadcasting advertisements to user operated, network-interconnected computers including a first computer operated by a first user and a second computer operated by a second user, the method including:

a) administrating status of users including the first user (e.g." Eileen Velet" ) and the second user (her friend) . (Recommend-it reads on friends of Eileen Velet signing up to the same service as well. The buddy list may be reciprocal lists i.e. Eileen Velet lists her friend as buddy and vice versa).

b) receiving from the first computer and broadcasting to the second computer the status of the first user ("Velet wants to you to check this site out" means Eileen velvet has been monitored as having visited that site );

c) correlatively recording in an advertising database (implicit) resource identification information specifying a resource on the network (URL of the game website visited by Eileen Velet" ) with a plurality of advertising information ( the game site description, the plural pieces of data that constitute "the juicy details" of the game site, also the tagged on other promotion : see at page 4, the financial ad "Green Mountain Asset" tagged to the email message). for the advertisements;

d) receiving from at least a third (advertiser) computer the resource identification information ( RECOMMEND-IT #1 line 2: " register your site now!"), at least one of the plurality of advertising information (information about the site) or a combination thereof, recorded in said recording

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e) detecting resource identification information for a first resource in use by the first user;

f) extracting first advertising information (e.g. details of the game) corresponding to the resource identification information (URL of the game site) , and recorded in said recording, for the first resource detected in said detection, wherein the extracted first advertising information is chosen from the recorded plurality of advertising information (e.g. details of the game, other ads such as “Green Mountain Asset” ) correlated to (implicit) the resource identification information;

g) broadcasting to the second computer said first advertising information extracted in said extraction; and

h) displaying (in the email) status of the first user on the second computer, said status represented by advertising data (description of the game site in the email shows the status of the 1<sup>st</sup> user as being at that site previously) included in said first advertising information broadcast, said displaying occurring in response to browsing by said first computer.

**Recommend-it does not disclose the broadcasting to the second computer being performed in response to a request by the second user (or a second user computer) for the status of the first user.**

**However, because people like to hear from friends, and value their recommendations, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein “PHOSITA”) that the second user would ask a friend (the first user) computer to send recommendations by adding him or her (second user) to the first user’s buddy list for recommendations.**

**This request even if made in person to the first user would read on “a request by the second user for the status of the first user” and clearly the broadcasting to the second computer would have been performed in response thereto (claims 1, 10, 15).**

**It would also have been obvious to a PHOSITA that the second user could make the request from his or her computer to the first user (e.g. via email or instant message) because such means of communication are convenient and widely used. In this case, the broadcasting to the second computer would have being performed in response to a request by the second user computer for the status of the first user (claims 12 and 14).**

**Recommend-it does not disclose the ads are represented by “a plurality of image data”, however Porat et al. discloses** email to buddies recommending a particular page and its URL visited by a shopper can include an image of the item or product viewed by the 1<sup>st</sup> user (paragraph [0049], see also Figure 7 “tell a friend” button, paragraphs [0048]-[0050]).

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Since “a picture is worth a thousand words” it would have been desirable and thus obvious to a PHOSITA to add Porat’s image teaching to the Recommend-it message to describe more efficiently or succinctly the web site (e.g. game site) recommended. It would also have been obvious to use the same picture or icon representation technique to efficiently represent additional ads such as the “Green Mountain Asset” ad tagged to the message.

Thus RECOMMEND-IT/Porat discloses “a plurality of image data “and the status of the 1<sup>st</sup> user being represented as image data, as claimed.

**8c. As to independent claims 2 and 9,**

**the limitations common to independent claims 1, 10, 12, 14-15 are disclosed as above discussed.**

RECOMMEND-IT does not specifically disclose receiving new (unregistered) ads information from these advertisers and designations of already registered resources.

However, Official Notice is taken that accepting new (unregistered) information from clients and correlating new information with other client’s data already belonging to the same clients is well-known in order to correlatively update the clients’ existing data with new data.

(Applicants again argue against this Official Notice ( Response page 11) but as stated earlier, does not point out with specificity the supposed errors i.e. did not state why the Official Notice not well-known therefore the challenge is defective. See MPEP 2144.03 C) .

*“To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241”....)*

Thus it would have been obvious to one skilled in the art at the time the invention was made to add these customary methods to the system of RECOMMEND-IT above to allow adding new advertising data (such as new details of the sites or new images/icons of ads] to the ad resources (e.g. the game URL’s in RECOMMEND-IT), in the correlative database to allow updating the data associated with the sites (e.g. icons, further details of the shopping or game sites) for the consumers’ benefit.

**8d. RECOMMEND-IT also disclose (dependent claim 4) at the citations above.**

**8e. RECOMMEND-IT does not specifically disclose (dependent claim 3) communicating with clients using their addresses, to ask their permission to correlate the new**

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information with certain existing data already registered as belonging to them, and with their permission, so perform the correlation, as claimed. However Official Notice is taken that asking permission in such situations is customary to ensure correct correlation of data, secure client authorization and thus their satisfaction.

(As stated earlier, arguments against this Official Notice have been defective as lacking specificity as well, see above).

Thus it would have been obvious to a PHOSITA to add such customary methods to RECOMMEND-IT for the above-discussed advantage.

**9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over RECOMMEND-IT/ Porat, and further in view of Goldhaber et al., US 5,794,210 and/or admitted art.**

**Dependent claims 5-8 (dependent on claims 4 and 6):**

RECOMMEND-IT/ Porat discloses claims 4, and 6 above and further RECOMMEND-IT/ Porat discloses linking from the recommended site represented by an image to the site and Porat further discloses interacting at the site to request detailed information associated with the ad sent, and the system returning the detailed information (Fig. 6; [0045]; [0046]).

However, Recommend-it does not disclose the steps of monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access.

However these steps are all disclosed either in Goldhaber (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3).

It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of Recommend-it to effect the ad compensation/charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

**10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al., US Application Publication 2006/0184886 and further in view of Goldhaber et al., US 5,794,210 and/or admitted art.**

**Independent claim 11:**



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Chung discloses:

An advertising method

using a status information administration system wherein a plurality of user terminals is interconnected via a network, information on user status sent from one of the plurality of user terminals is acquired and administrated for each user, look-up requests for status information designating at least one user are received, and administrated user status information correlated with the users is sent to requestor user terminals

([0045]; [0046]; [0192]; [0227] :a “status information administration system” is a system that continuously broadcasts status information regarding its users’ presence such as browsing, see [0203]; [0204], [0227]: co-browsing).

the advertising method comprising:

detecting information identifying a network resource requested from one of the plurality of user terminals and correlatively recording the detected information with user information identifying a user using the user terminal ([0132][0133]: pages accessed by 1<sup>st</sup> user are identified), [0158]: tracking 1<sup>st</sup> user );

accepting a status information look-up request designating at least one user from one of a plurality of user terminals, the look-up request being sent from a user other than the designated at least one user ([0227], [0157] - [0160]),

acquiring network resource identification information correlatively recorded with the user designated by the status information request ([0132]-[0133]: pages accessed by 1<sup>st</sup> user are identified),

acquiring and sending to the look-up requestor user (2<sup>nd</sup> user) terminal at least one chosen from a plurality of advertising data correlatively stored for each network resource by advertisers (on receiving requests in advance from an advertiser terminal device) ([0134]; [0135]; [0182]; [0203]; [0204], [0227]: **co-browsing by 2<sup>nd</sup> user**--when 1<sup>st</sup> user browses commercial sites, see [0048])-- means 2<sup>nd</sup> user is sent commercial pages which usually have plural advertising data thereon, or which can be “infinitely” linked for further information (see [0133], which reads on further ad details, implicitly sent to the system for recording and correlation by advertisers) )

Chung does not disclose the steps of monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access.

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However these steps are all disclosed either in **Goldhaber** (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3) .

It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of Recommend-it to effect the ad compensation/charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

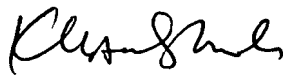
Wong, US 6708172, discloses co-shopping , browsing, conference.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

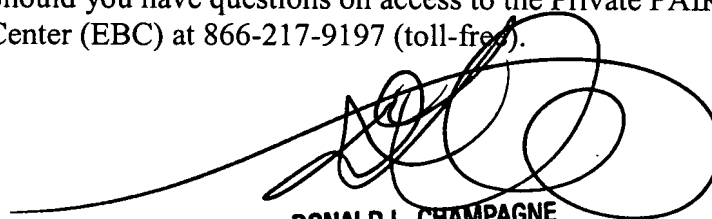
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 7, 2007



KHL



**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**